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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/932,704 | 09/18/97 | MORPER | H P97.1957 |

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EXAMINER

CRAVER, C

ART UNIT

PAPER NUMBER

2744

DATE MAILED:

10/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/932,704

Applicant(s)

Morper

Examiner

Charles Craver

Group Art Unit

2744



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____
- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-6, 10-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan, U.S. Patent #5,673,308.

Regarding claims 1, 10 and 15, Akhavan discloses:

a method for controlling calls in a cellular network, comprising

calling, using a telephone number, wireless terminal equipment (i.e. mobile station)

wirelessly connected to base stations of a general (reads home) area, said base stations being connected to communication terminals in said network (i.e. MSC, MTSO), said mobile unit being additionally connected wirelessly to a sub-network of said network (abstract, column 22 lines 3-12 and 22-36, figures 3 and 4);

switching calls directed to a called mobile unit to an appertaining base station in said general area, availability of said mobile unit being determined by said communication terminals;

and

rerouting the call, given non-availability of the called mobile unit, to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65).

Akhavan discloses applicants invention, except that the availability of the mobile unit is determined by the base station, and is thus used in rerouting the call.

However, it was well known in the art at the time the invention was made to determine the availability of a user at the base station (i.e. via HLR, VLR) to keep the MSC from overuse, or, alternately, to incorporate an MSC into a base station so as to lower system complexity. The examiner takes official notice as such. Either option was well known, and would meet applicants limitation of using the base station to determine user availability, and further said base station would inherently be involved in the rerouting of the call in non-availability is determined. It would have been obvious to one skilled in the art to move such a function from an MSC to the base station, because, as mentioned previously, it would keep the MSC from overuse, or in the alternate, lower system complexity, and would thus be a routine engineering decision predicated on system size and ability.

Further regarding claims 2, 10 and 16,

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Further regarding claims 6, 14 and 15,

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Regarding claims 3, 11 and 17,

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

Regarding claims 5 and 13,

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

4. Claims 4, 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 1 above, and further in view of the applicant's own admission of prior art.

Regarding claims 4, 8 and 9,

Akhavan, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT or GAP or CAP standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard or a GAP or CAP standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9, page 2 lines 5-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT and CAP or GAP standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

Regarding claim 7,

Akhavan, while disclosing a call deflection method, does not disclose that the communication terminal is implemented according to one of an SO and UKO-ISDN access.

However, it is well known in the art to apply an access standard such as SO or UKO-

ISDN access to an ISDN connection in a wireless communication protocol, and the examiner takes official notice as such.

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the SO or UKO-ISDN standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 10 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

Response to Arguments

7. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Urs et al discusses a method for connecting a mobile unit to a sub-communication network from a parent network using base stations.

Zicker et al ('259) discusses a method for using a mobile unit in connection with several base stations which are in communication with each other.

Zicker discusses a multiple mode cordless phone connected wirelessly to a main network and a sub-communication network within said main network.

D'Avello et al discusses multiple mode cordless phone which is connectable to a main network, a microcellular network and a sub-communication network within said main network.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

C. Craver
October 4, 1999

CC

CHARLES CRAVER
PATENT EXAMINER

Tracy M. LeBree
TRACY M. LEBREE
PATENT EXAMINER
10/4/99